

Application No.: 10/714,403Docket No.: 2038-307**REMARKS**

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested. Entry of this Amendment under Rule 116 is merited as it raises no new issues and requires no further search.

Claims 13-18 and 20-22 are pending in the application. Claims 1-12 and 19 have been cancelled to simplify the issues. Claim 13 has been rewritten in independent form including all limitations of base claim 1. Claims 13 and 20 have been amended to overcome the 35 U.S.C. 112, *second paragraph* rejection. In particular, claims 13 and 20 have been amended to additionally recite a motor for rotating the rotary base, and claim 13 has further been amended to include a second belt, as kindly suggested by the Examiner in page 3, the last paragraph of the Final Office Action. Amended claims 13 and 20 find solid support in the original specification, especially, at page 12, line 8, and page 13, lines 3-7. No new matter has been introduced through the foregoing amendments.

The amendments to claims 13 and 20 should be entered because they do not raise new issues or require further search.

In particular, claims 13 and 20 have been amended to only include limitations which should reasonably have been expected to be claimed. See MPEP § 904.02(a), at page 900-52, the right column, lines 7-11 from bottom. In addition, in view of the Examiner's comments found in paragraph 5 of the Final Office Action, one would reasonably expect that the Examiner's rejection under 35 U.S.C. 112, *second paragraph* for the reason of incompleteness would be replied to by an amendment supplying the omitted elements, i.e., a motor for rotating the rotary base and a second belt for driving the second tables now recited in amended claims 13 and 20. Thus, the amendments do not raise new issues.

Finally, the added limitations are all taught by the applied references. In particular, the

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primary reference of *Spatafora* teaches a motor at column 3, line 39 and in FIG. 2 (at the upper right corner), whereas the teaching reference of *deMey* teaches multiple belts at 52 and 54 as held by the Examiner in paragraph 4 of the Final Office Action (the obviousness rejection of claim 9 which recites a second belt). Therefore, the amendments do not require further search.

Accordingly, Applicants respectfully submit that this Amendment does not raise new issues or require further search, and hence, should be entered.

The 35 U.S.C. 112, second paragraph rejection is believed overcome in view of the above amendments.

The art rejections of claims 1-3, 5-6, 8-12 and 19 are moot as the rejected claims have been cancelled.

The 35 U.S.C. 103(a) rejection of claims 13-18 and 20-22 as being obvious over *Spatafora* in view of *Buhrer* and *Osti* is traversed, because a prima facie case of obviousness has not been properly established.

A proper obviousness analysis involves a three-step process.

1. First, Office personnel should establish a prima facie case of unpatentability considering the factors set out by the Supreme Court in *Graham v. John Deere*. See, e.g., *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) ("The PTO bears the burden of establishing a case of prima facie obviousness."); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), requires that to make out a case of obviousness, one must (A) determine the scope and contents of the prior art; (B) ascertain the differences between the prior art and the claims in issue; (C) determine the level of skill in the pertinent art; and (D) evaluate any evidence of secondary considerations.

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To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

2. If a prima facie case is established, the burden shifts to applicant to come forward with rebuttal evidence or argument to overcome the prima facie case. See, e.g., *Bell*, 991 F.2d at 783-84, 26 USPQ2d at 1531; *Rijckaert*, 9 F.3d at 1532, 28 USPQ2d at 1956; *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444.

3. Finally, Office personnel should evaluate the totality of the facts and all of the evidence to determine whether they still support a conclusion that the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. *Id.*

In this particular case, the Examiner has clearly failed to meet the burden of establishing a prima facie case of obviousness. More specifically, the 35 U.S.C. 103(a) rejection manifested in paragraph 2 of the Final Office Action has failed to specify any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See the Final Office Action, page 2, the last paragraph, the first sentence. With respect to claims 14, 15, 21 and 22, the Examiner's rejection has also failed to specify any suggestion or motivation to modify the reference or to combine reference teachings. See the Final Office Action, page 2, the last paragraph, the second sentence. The Examiner's allegation that the claimed structure has not been shown to be critical to the operation of the system does not mitigate the initial burden of establishing a prima facie case of

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obviousness. Furthermore, the Final Office Action is absolutely silent on the differences between the prior art and claims 16-18, failing to consider *Graham v. John Deere Co.*'s factor B. Therefore, Applicants respectfully submit that a prima facie case of obviousness has not been properly established.

Since a prima facie case of obviousness has not been properly established, Applicants are not required to come forward with rebuttal argument or evidence. See point 2 above. The Examiner cannot require Applicants to show criticality of the claimed structure because he has not met his initial burden of establishing a prima facie case of obviousness. The burden has not yet shifted to Applicants.

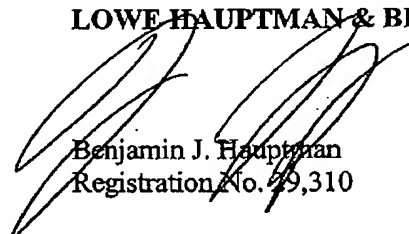
Accordingly, Applicants respectfully submit that the 35 U.S.C. 103(a) rejection of claims 13-18 and 20-22 is erroneous and should be withdrawn.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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